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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,709	10/30/2003	Edward W. Merrill	37697-0080	6478

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EXAMINER	
BERMAN, SUSAN W	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/696,709	MERRILL ET AL.	
	Examiner	Art Unit	
	Susan W. Berman	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *124-134* is/are pending in the application.

4a) Of the above claim(s) *128-134* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *124-127* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restriction

Newly submitted claims 128-134 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 124-127, drawn to a method comprising pre-annealing polyethylene preform, irradiating the preform and quenching free radicals in the preform, classified in class 522, subclass 161.

II. Claims 128-132, drawn to a method comprising melting a polyethylene preform, irradiating the preform and quenching free radical in the preform, classified in class 522, subclass 161.

III. Claims 133-134, drawn to a method comprising irradiating a polyethylene preform that has been melted, quenching free radicals in the preform and forming the preform into a prosthetic bearing, classified in class 264, subclass 331.17.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and would be expected to have different effects. The Group I process comprises a pre-annealing step that is not recited in the methods of Group II or Group III. The Group II process requires a melting step that is not recited in the methods of Group I or Group III. The Group III process does not require the melting step of Group II or the pre-annealing step of Group I.

Because these inventions are distinct for the reasons given above and the search required for Group II or III is not required for Group I, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 128-134 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments filed 09/29/2005 have been fully considered but they are not persuasive.

Applicant argues that the examiner has not determined whether the provisional application of Saum et al '158 contains the disclosure in the '158 patent to support the earliest filing date of Oct. 2, 1996. Applicant further argues that the examiner has not addressed the priority benefit of parent applications 08/726,313 (10/2/1996) and 08/600,744 (2/13/1996).

In response, the rejection of claims over Saum et al (6,316,158) is hereby withdrawn. Saum et al '158 has an effective filing date of 10/02/1996 which is the same as the effective filing date, 10/02/1996, of the instantly claimed invention with respect to the instant claims. Applicant's effective filing date with respect to the instant claims is considered to be 10/02/1996, the filing date of SN 08/726,313. None of the instant claims 124-127 is clearly drawn to a method comprising irradiation of polyethylene in the melted state (MIR) as disclosed in SN 08/600,744 (US 5,879,400) having a filing date of 02/13/1996. It is further noted that the instant claim language of claims 124-127 is not considered to be supported by the disclosure as filed (or in SN 08/726,313).

Applicant's arguments with respect to claims 124-127 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 124-127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner has not found any disclosure of "pre-annealing" or "at a temperature greater than ambient temperature and less than the decomposition temperature" or for a "period of time greater than about 30 minutes" of polyethylene. The examiner has not found any disclosure of "quenching residual free radicals" in the polyethylene perform. The examiner has not found any disclosure of cooling after the "quenching step" to a "temperature below the melting temperature" of the polyethylene. Applicant is reminded that claim language should correspond to the description as filed.

US 5,879,400 discloses a method wherein polyethylene is "heated at or above its melting temperature" for a "period of about 5 minutes to about 3 hours", followed by irradiation to crosslink, cooling at a rate equal to or greater than about 0.5^0 C/min., and then machined or compression molded (column 2, lines 30-52). The examples disclose heating to about 175^0C and holding at the steady state temperature for 30 minutes before starting irradiation, followed by irradiation and cooling at a rate of about 0.5^0 C/min. and then by machining.

US SN 08/726,313, filed 10-02-1996, includes the disclosure of melt irradiation set forth in US '400 and also discloses variations on irradiation (warm or cold) followed by melting so that there are substantially no detectable free radicals. The method of WIR-SM includes pre-heating UHMWPE to a temperature below the melting point, irradiation and subsequent melting. This disclosed method appears to be closest to the instantly claimed method but fails to provide support for the wording used in the

instant claims. There is no mention of pre-annealing, decomposition temperature, quenching, time period greater than about 30 minutes.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 124 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 124, the phrase "greater than about 30 minutes" is indefinite because it is not clear whether applicant intends to claim a "time greater than 30 minutes" or a "time of about 30 minutes".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 124-127 are rejected under 35 U.S.C. 102(e) as being anticipated by Salovey et al (6,281,264, having an effective filing date of 01/20/1995). Salovey et al teach a method for crosslinking UHMWPE for forming in vivo implants. The method comprises irradiation crosslinking of a molten polymer. See column 3, lines 50-59, column 4, line 42, to column 5, line 66, column 11, line 38, to column 12, line 11, column 13, lines 44-54. Salovey et al report the effects of the disclosed method on % crystallinity.

Claims 124-127 are rejected under 35 U.S.C. 102(e) as being anticipated by Shalaby et al (5,824,411). Shalaby et al disclose a method that comprises melting an UHMWPE "construct polymer-fiber" and irradiating the resulting composite with high energy radiation to sterilize and crosslink composites of the UHMWPE. See column 2, lines 11-27, column 3, lines 9-18, column 5, line 32, to column 6, line 10, and Examples 1 and 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 124-127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al (5,414,049). Sun et al teach a method for forming a medical implant comprising annealing a medical implant and then radiation sterilizing the implant. The irradiated implant is then further annealed to reduce free radicals. The difference from the instantly claimed process is that Sun et al teach treating a formed implant rather than a perform. It would have been obvious to one skilled in the art at the time of the invention to apply the process steps taught by Sun et al to a polyethylene preform. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of imparting the desirable properties taught by Sun et al to a preform material since the polymeric material is polyethylene in the implant and in the preform.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 124-127 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 124-126 and 128-133 of copending Application No. 10/948440. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same methods steps, i.e. melting and irradiating polyethylene, are set forth in the claims of '440 and in the instant claims. It would have been obvious to one skilled in the art at the time of the invention to employ UHMWPE as the polyethylene in the method steps set forth in the claims of '440. It would have been obvious to one skilled in the art at the time of the invention to perform the irradiation and heating steps set forth in the claims of '440 in a substantially oxygen-free atmosphere in order to avoid oxidation of the UHMWPE.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 124-127 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 124, 126-129 and 135-137 of copending Application No. 10/197209. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same methods steps, i.e. heating above the melting temperature and

irradiating the polyethylene, are set forth in the claims of '209 and in the instant claims. It would have been obvious to one skilled in the art at the time of the invention to employ UHMWPE as the polyethylene in the method steps set forth in the claims of '209. It would have been obvious to one skilled in the art at the time of the invention to perform the irradiation and heating steps set forth in the claims of '209 in a substantially oxygen-free atmosphere in order to avoid oxidation of the UHMWPE.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 124-127 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 124-127 of copending Application No. 10/696362. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same methods steps, i.e. heating above the melting temperature and irradiating the UHMWPE are set forth in the claims of '362 and in the instant claims. It would have been obvious to one skilled in the art at the time of the invention to perform the irradiation and heating steps set forth in the claims of '362 in a substantially oxygen-free atmosphere in order to avoid oxidation of the UHMWPE. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 124-127 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 114 and 124-129 of copending Application No. 10/901089. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same methods steps, i.e. heating above the melting temperature and irradiating the heated UHMWPE are set forth in the claims of '089 and in the instant claims. It would have been obvious to one skilled in the art at the time of the invention to perform the irradiation and heating steps set forth in

the claims of '089 in a substantially oxygen-free atmosphere in order to avoid oxidation of the UHMWPE. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 124-127 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 124,125,129,130,132-134,136, 138, and 145-152 of copending Application No. 10/197263. Although the conflicting claims are not identical, they are not patentably distinct from each other because the fabricated articles set forth in the claims of '263 are produced by irradiating and melting UHMWPE, as are the products set forth in the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB
12/26/2005

Susan W Berman
Primary Examiner
Art Unit 1711